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MAILED
MAR 01 2012
OFFICE OF PETITIONS

In re Patent of Corrado :
Patent No. 5,731,655 :
Issue Date: March 24, 1998 : Letter
Application No. 08/614,212 :
Filing Date: March 12, 1996 :
For: Spark Plug With 360 Degree
Firing Tip :
:

Request for Information

This letter is in response to a petition under 37 C.F.R. § 1.378(b) filed January 23, 2012.

Fees

The petition does not include the required maintenance fee of \$2,365 or the required surcharge of \$700. Relief under 37 C.F.R. § 1.378(b) cannot be granted absent payment of these fees.

As will be discussed, the Office strongly recommends Petitioner submit these fees on or before March 24, 2012.

Facts

The 11.5 year maintenance fee could have been timely paid, with a surcharge, as late as March 24, 2010. The fee was not timely paid and the patent expired on March 25, 2010.

A petition under 37 C.F.R. § 1.378(b) was filed January 23, 2012.

The petition includes income, expense, and asset information with respect to the time period beginning January 2009 and ending April 2010.

The Petition does not Establish Petitioner was Aware the Maintenance Fee was Due

Petitioner has not shown the maintenance fee would have been paid but for an inability to pay the fee. For example, Petitioner has not shown Petitioner knew of the fee and desired to pay the fee, but simply could not afford to pay the fee. Any response to the instant request must

demonstrate Petitioner knew the fee was due or prove Petitioner's lack of knowledge the fee was due was unavoidable.

The Petition Incorrectly Identifies the Date the 11.5 year Maintenance Fee was Due

The petition states the maintenance fee was "due March 2011." However, the last date the fee could have been paid without the submission of a surcharge was March 24, 2010.

Petitioner Inconsistently Identifies the Month of Foreclosure on Petitioner's House

The petition states Petitioner received a notice from his mortgage company seeking foreclosure on his home during early 2009, and indicates he left his property within three days of receiving the notice. However, the financial information attached to the petition strongly implies the foreclosure took place during March 2010. Any response to the instant request must address the prior inconsistency.

The Financial Information Ignores the Time Period From May 2010 until January 2012

Although Petitioner has provided financial information for each month for the time period beginning January 2009 and ending April 2010, Petitioner has not provided financial information for the time period beginning May 2010 and ending January 2012.

A grantable petition under 37 C.F.R. § 1.378(b) must establish the entire delay in the submission of the maintenance fee was unavoidable. In other words, the petition must establish,

1. The failure to timely pay the maintenance fee was unavoidable; and
2. The delay in filing the maintenance fee and a petition to reinstate the patent, beginning on the date the patent expired and ending on the date a petition was filed, was unavoidable.

Any response to the instant request must address the time period beginning May 2010 and ending January 2012.

The Expense Information is Incomplete

Petitioner states the expense information "does not include FOOD, GASOLINE, CHILD EXPENSES, etc." If Petitioner wishes for the Office to take these expenses into consideration when determining if the record demonstrates the entire delay in the submission of the maintenance fee was unavoidable, Petitioner must provide reasonable estimates for these expenses.

The Asset Information is Incomplete

The financial information for January 2009 indicates Petitioner owns rental property. However, the rental property is not listed as an asset.

The financial information states the expense information does not include expenditures for gasoline and indicates \$155 was paid for an "Auto Club" for January 2009 and February 2009. However, the financial information does not identify a car as an asset.

Any response to the instant request must identify all assets owned, in whole or in part, by Petitioner during any portion of the relevant time periods and the value of each of the assets. Petitioner should ensure any asset information provided to the Office is accompanied by relevant liability information.

The Income Information May be Incomplete

Petitioner states child expenses have not been identified and Petitioner has not stated Petitioner is single. Therefore, it appears Petitioner's income *may* not have been the only income received by his household during all relevant time periods.

Any response to the instant request must identify all parties living with Petitioner during the relevant time periods and the income received by each of the parties during the relevant time periods.

If another person living with Petitioner had any income during the relevant time periods, one would expect such a person to have some responsibility for paying expenses incurred by the household. However, Petitioner appears to be asserting he was solely responsible for the home mortgage and numerous other expenses. If another person living with Petitioner had any income during the relevant time periods, any response to the request for reconsideration should fully address the extent to which the other person did, or did not, contribute to the payment of the expenses identified by Petitioner.

Portions of the Budgetary Information Provided by Petitioner are Unclear

Portions of the budgetary information are unclear.

Examples: The budgetary information refers to money paid to "Mortgage World Savings." However, the information does not state whether or not Mortgage World Savings held a mortgage on the primary residence or the rental property.

The budgetary information refers to money paid to "Homecomings Financial Mortgage." However, the information does not state whether or not Homecomings Financial Mortgage held a mortgage on the primary residence or the rental property.

The budgetary information refers to money paid each month to "Home Depot" without any discussion of the reason for paying money to Home Depot each month.

Any response to the instant request should ensure all information provided by Petitioner is clear.

The Information Fails to Address Petitioner's Ability to Sell the Rental Property

Petitioner fails to indicate the extent to which Petitioner could have sold the rental property to obtain money to timely pay the maintenance fee or to reinstate the patent on an earlier date.

Any response to the instant request should discuss the Petitioner's ability to sell the rental property. Such a discussion should explicitly identify the value of the property during all relevant time periods and the debt owed on the property during all relevant time periods.

Petitioner has not Identified the Date Petitioner Learned the Patent had Expired

A grantable petition under 37 C.F.R. § 1.378(b) must identify the date a petitioner learned the patent expired. However, the instant petition fails to identify the date Petitioner learned the instant patent had expired. Any response to the instant request must to identify the date Petitioner learned the instant patent had expired.

Petitioner Should Ensure Petitioner Submits all Information Petitioner Wishes to be Considered by the Office

Petitioner will be based solely on the administrative record. Therefore, if Petitioner wishes for the Office to take any information into consideration, Petitioner must make the information part of the record. Petitioner should note Petitioner bears the burden of proving the entire delay in the submission of the 11.5 year maintenance fee was unavoidable.

Petitioner's Current Options

I. Petitioner May File a Response to the Instant Request and Continue to Seek Reinstatement of the Patent under 37 C.F.R. § 1.378(b).

Any response to the instant request must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted. The response should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.378(b)."

Although the response to the instant request can be timely filed as late as two months from the instant decision, a failure to file the required fees on or before March 24, 2012, will preclude Petitioner from seeking relief under 37 C.F.R. § 1.378(c) in the future if relief cannot be obtained under 37 C.F.R. § 1.378(b). In other words, unless the fees are timely mailed in compliance with 37 C.F.R. §§ 1.8 or 1.10, the Office must *receive* the fees on or before March 24, 2012, if Petitioner wishes to preserve the ability to pursue relief under 37 C.F.R. § 1.378(c) in the future.

II. Petitioner May File a Petition under 37 C.F.R. § 1.378(c).

Petitioner may wish to consider filing a petition to reinstate the patent based on unintentional expiration under 37 C.F.R. § 1.378(c). A copy of a blank petition form PTO/SB/66 is enclosed for petitioner's convenience. The surcharge for an unintentional petition is \$1,640. Therefore, if

a petition under 37 C.F.R. § 1.378(c) is filed, the petition will need to be accompanied by \$2,365 for the required maintenance fee and \$1,640 for the surcharge. In general, a petition under 37 C.F.R. § 1.378(c) only needs to state the expiration of the patent was “unintentional,” whereas a petition under 37 C.F.R. § 1.378(b) must prove that the entire delay in payment of the fee was “unavoidable.”

III. Petitioner May Allow the Patent to Remain Expired.

The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter. Therefore, if Petitioner decides not to continue pursuing the reinstatement of the patent, Petitioner may simply choose not to respond to the instant request.

Future Correspondence

Further correspondence with respect to this matter should be addressed as follows:

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹ Document Code “PET.OP” should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.